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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,617	04/25/2005	Wenlong Deng	53624/DBP/C306	1639

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CHRISTIE, PARKER & HALE, LLP
PO BOX 7068
PASADENA, CA 91109-7068

EXAMINER	
CLARK, AMY LYNN	
ART UNIT	PAPER NUMBER
1655	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/510,617	DENG, WENLONG	
	Examiner	Art Unit	
	Amy L. Clark	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *11-16* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/17/2007 has been entered. In view of Applicant's newly amended claims, the following election/restriction requirement is issued.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 11, 12 and 15, drawn to a pharmaceutical mixture for treating rheumatisms consisting essentially of: *Tripterygium hypoglaucum*, *Epimedium brevicornum*, *Lycium barbarum*, and *Cuscuta chinensis*.

Group II, claim 13, drawn to a method for preparing a pharmaceutical mixture for treating rheumatisms consisting essentially of: *Tripterygium hypoglaucum*, *Epimedium brevicornum*, *Lycium barbarum*, and *Cuscuta chinensis*: consisting essentially of extraction of each herb with an aqueous ethanol mixture.

Group III, claims 14, drawn to a method for preparing a pharmaceutical mixture for treating rheumatisms consisting essentially of: *Tripterygium hypoglaucum*, *Epimedium*

brevicornum, *Lycium barbarum*, and *Cuscuta chinensis*: consisting essentially of extraction of each herb with water followed by placing the extracts on a column and eluting.

Group IV, claims 16, drawn to a method for preparing a pharmaceutical mixture for treating rheumatisms consisting essentially of: *Tripterygium hypoglaucum*, *Epimedium brevicornum*, *Lycium barbarum*, and *Cuscuta chinensis*: consisting essentially of extraction of each herb with numerous, specific and involved steps of water extraction followed by filtration and eventually running the extracts down a column and eluting.

Group I is drawn to a pharmaceutical mixture for treating rheumatism consisting essentially of: *Tripterygium hypoglaucum*, *Epimedium brevicornum*, *Lycium barbarum*, and *Cuscuta chinensis* and Groups II and III are drawn to methods of making the pharmaceutical mixture. However, Groups II and III recite different solvent systems and very different method steps, wherein the method of Group II provides a crude aqueous ethanol extract and the method of Group III provides a purified aqueous extract and Group IV provides a purified aqueous extract made from very different steps from Group II and Group III. Neither Group II nor Group III nor Group IV are related, since they recite different method steps, particularly since Group II recites an aqueous ethanol extraction to provide a crude product, Group III recites an aqueous extraction method involving column chromatography and Group IV recites an aqueous extraction method involving filtration and very different method steps from Group III.

Furthermore, claim 11, at least, is anticipated by or obvious over Xu et al. (N*, CN 1178697 A, Abstract only), in view of Li et al. (O*, CN 1051859 A, Abstract only), Xiong et al. (P*, CN 1097313 A, Abstract only) and Wang (Q*, CN 1146348 A, Abstract only). Xu teaches a medicine for rheumatism comprising Tripterygium hypoglaucum and the fruit of barbary wolfberry (which is synonymous with *Lycium barbarum*). Li teaches a therapeutic composition for treating rheumatoid arthritis obtained by extraction of *Tripterygium wilfordii* (which is synonymous with *Tripterygium hypoglaucum*), adding ethanol and combining with aqueous beta-cyclodextril solution. Xiong teaches a snake spirit for treating rheumatism comprising herb of shorthorned epimedium (which is synonymous with *Epimedium brevicornum*) and ripe fruit of barbary wolfberry (*Lycium barbarum*). Wang teaches a multi-functional health care medicinal liquor comprising fruit of Chinese wolfberry (which is synonymous with *Lycium barbarum*) and seed of Chinese dodder (which is synonymous with *Cuscuta chinensis*) having a curative effect for rheumatism.

Therefore, the invention lacks unity since it does not form a single general inventive concept and there is no technical relationship among the claimed inventions because the inventions do not correspond to one or more special technical features evident, as

determined "*a priori*". See MPEP 1850 (I and II), which, in part, states:

An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step. For example, a document discovered in the international search shows that there is a presumption of lack of novelty or inventive step in a main claim, so that there may be no technical relationship left over the prior art among the claimed inventions involving one or more of the same or corresponding special technical features, leaving two or more dependent claims without a single general inventive concept.

Lack of unity of invention may be directly evident "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to

be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy L. Clark whose telephone number is (571) 272-1310. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amy L. Clark
AU 1655

Amy L. Clark
January 29, 2008

MICHELE FLOOD
PRIMARY EXAMINER